

REMARKS

In the Rejection of the Reopened Prosecution dated 12/17/2004, the examiner respectfully rejected Claims 1-2 under 35 U.S.C. § 102(b) as being anticipated by Chou et al ('536). The examiner respectfully rejected Claims 1-2 under 35 U.S.C. § 102(b) as being anticipated by Tatsumi ('831). Further, the examiner respectfully rejected Claims 3 and 5-6 under 35 U.S.C. § 103(a) as being unpatentable over Chou et al or Tatsumi in view of Murphy, and rejected claims 4 and 7 in view of Chou et al or Tatsumi in view of Carso et al. Further still, the examiner respectfully rejected Claims 3 and 5-6 under 35 U.S.C. § 103(a) as being unpatentable over Chou et al or Tatsumi in view of Murphy, and rejected claims 4 and 7 in view of Chou et al or Tatsumi in view of Carso et al.

Claim 2 has been canceled without prejudice, with claim 1 amended to include a translucent tube circumscribing the shaft to refract and enhance illumination directed therethrough.

To summarize each of the cited references:

Chou et al discloses a lighted umbrella having a transparent, solid, polygonal shaft supporting a refractory material such that when light in the handle is directed through the refractory material the light is directed upward at the underside of the umbrella head.

Tatsumi discloses an umbrella with lighted shaft and claims the sole improvement of a spiral bundle of optical fibers within the shaft for carrying and directing the light from a light source in the handle.

Carso et al. discloses a disposable umbrella having a shaft that forms a cut-out sectional

compartment for retaining a chemiluminescent 'light stick'. When the light stick is activated, it forms an illumination source attached to the umbrella shaft.

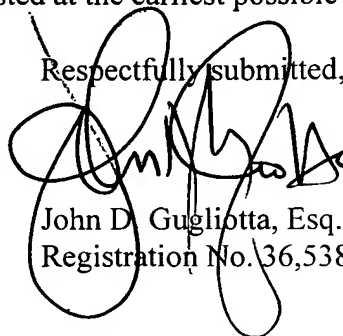
Murphy discloses a lighted umbrella having a light fixture formed within a concavity defined by the undersurface of the canopy when the canopy is opened. A light fixture mounted in the concavity and facing downward directs light from the fixture towards the ground when the open umbrella is vertically oriented.

All of these references disclose a combination of umbrella and illumination means, yet all were considered allowable over the others. All provide minor incremental improvements, i.e. Tatsumi adds fiber optic light transmission; Chou et al. adds a hollow, translucent shaft for light transmission; Carso et al adds a chemiluminescent light stick for lighting; and Murphy adds an illumination means housed in a concavity formed in the umbrella canopy. It would appear that the level of ordinary skill in this art is adequately represented by the disclosures of the various references relied upon in the rejections. Ex parte Anderson, 21 USPQ 2d 1241, 1254 (B.P.A.I. 1991) Therefore, it would appear that the addition of a translucent, neon-colored tube circumscribing the shaft of the umbrella would also be an incremental improvement of a similar type already recognized as being patentably distinguishable within this art. And, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992) . And, it is not pertinent whether the prior art device possess the functional characteristics of the claimed invention if the reference does not describe or suggest its structure. In re Mills, 16 USPQ 2d

1430, 1432-33 (Fed. Cir. 1990)

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John D. Gugliotta", is written over the typed name and registration number.

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